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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,559	05/07/2001	Hisaaki Chaki	206704US0PCT	8747
22850	7590	03/25/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			O SULLIVAN, PETER G	
			ART UNIT	PAPER NUMBER
			1621	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/830,559	Applicant(s) CHAKI ET AL.	
	Examiner Peter G O'Sullivan	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 37-50 is/are pending in the application.
- 4a) Of the above claim(s) 5-8, 11-15, 22-27, 31, 42, 43 and 47-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10, 16-21, 28-30, 32-35, 37-41, 44-46 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-35 and 37-50 are pending in this application which should be reviewed for errors. In response to the restriction requirement, applicants elected the invention of group II with traverse. In response to the requirement for the election of a single disclosed species, applicants' elected the species of claim 19. Applicants' compounds of the scope of claim 11, wherein W is ZCOOR₂, n is 1 or 2 and X₁ is carbonyl are examined therewith with applicants' other compounds and claims 5-8, 11-15, 22-27, 31, 42, 43 and 47-49 held withdrawn from consideration.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 30 and 32-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds and methods relating thereto, does not reasonably provide enablement for all possible compounds of the scope of applicants' pharmacophore. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The claims describe relationships between the atoms of the pharmacophore but do not set forth a generic structure for the compounds. Compounds such as phosphines would be claimed for which there is not adequate enablement in the specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 9, 10, 16-21, 28-30, 32-35, 37-41, 44-46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agback et al., EP 0 150 166. Agback et al. disclose generically overlapping compounds set forth in generic formula I wherein R7-R11 may be, for example, alkoxy or hydroxy and A may be carbonyl. The compounds of Agback et al. may be used to treat inflammation, circulatory disorders, cancer, etc. The instant invention differs from the teaching of Agback et al. in that although close compounds such as that of example 39 are produced, applicants' compounds are not actually exemplified and additionally in that applicants' compounds may be n=2 as well as 1. It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of Agback et al. and in view of close compounds already made, to make further generically disclosed compounds and to expect them to be useful in treating inflammation, circulatory disorders, cancer, etc. Homologues/position isomers are considered obvious

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In re Mills, 126 U.S.P.Q. 513. Applicants' claim treatment of AP-1 mediated diseases, yet the diseases overlap with those disclosed by Agback.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G O'Sullivan at telephone number (571)272-0642.

P. G. O'S
PETER G SULLIVAN
PRIMARY EXAMINER
GROUP 1200